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MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/990,670	HICKS, THOMAS
	Examiner Elena Tsoy	Art Unit 1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 40,41,59-65 and 67-86 is/are pending in the application.
- 4a) Of the above claim(s) 38,39,42-50,52,53,66 and 87-90 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 40,41,59-65 and 67-86 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) Interview Summary (PTO-413) Paper No(s) _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Response to Amendment

1. Amendment filed on 6/23/2006 has been entered. Claims 4, 5, 22-26, 36, 51 and 54-58 have been cancelled. New claims 89-90 have been added. Claims 38-50, 52, 53, 59-90 are pending in the application. Claims 38-39, 42-50, 52-53, and 66 are withdrawn from consideration as directed to a non-elected invention.

Election/Restrictions

2. Claims 87-88 as amended are now directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they recite a new limitation of printing a plurality of *uniformly distributed dots of translucence-causing* material onto colored layers of transparent inks, which is in fact a limitation of **half-tone printing** a material over printed transparent inks to provide a translucent finish, recited in originally filed non-elected claims 7-18. Claims 7-18 were restricted out from the current invention in the Office Action mailed on 12/18/2002 and later Applicants canceled them as drawn to non-elected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, amended claims 87-88 and newly submitted claims 89-90 depending on the claims 87-88 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Objection to Claims 40, 41, 78 because of the informalities has been withdrawn due to amendment.
4. Objection to Claim 70 because of the informalities has been withdrawn due to amendment.
5. Claim 73 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 73 recites that the film covers only a portion of the window, while independent claim 40 recites that the film substantially covers the window.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 40, 59-65, and 67-86 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record set forth in paragraph 9 of the Office Action mailed on 3/24/2006.

8. Rejection of claim 41 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn due to amendment.

9. Claims 40-41, 59-65, 67-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim(s) 40 and 78 recite “printing” sufficient opaciters, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed describes printing inks to create images but not opaciters.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 40, 41, 59-65, and 68-86 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record set forth in paragraph 12 of the Office Action mailed on 3/24/2006 because “printing” opaciters does not remove reason for rejection.

9. Rejection of claim 67 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Rejection of claims 40, 41, 60, 61, 63, 64, 67, 74, 75, 79-82 under 35 U.S.C. 103(a) as being unpatentable over Oberwager (US 3,815,263) in view of Holt (US 4,127,689), further in view of Bakker et al (US 5959067) has been withdrawn due to amendment. However, Claim 78 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager (US 3,815,263) in view of Holt (US 4,127,689), further in view of Bakker et al (US 5959067) for the reasons of record set forth in paragraph 14 of the Office Action mailed on 3/24/2006 because the amendment did not change scope of the invention.

12. Rejection of claim 59 under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Chmielnik has been withdrawn due to amendment.

13. Rejection of claims 62, 65, 68, 83-86 under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Charley et al (US 6,030,002) has been withdrawn due to amendment.

14. Rejection of claim 64 under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Boden (US 3,562,941) has been withdrawn due to amendment.

15. Rejection of claims 69-73, 76-77 under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, in view of Bakker et al, further in view of Charley et al, and further in view of Taylor et al (US 5,672,413) has been withdrawn due to amendment.

16. Claims 40-41, 60-65, 67-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al (US 4078492) in view of Idland (US 4749222), further in view of Charley et al (US 6,030,002), and further in view of Bakker et al (US 5959067).

Levy et al disclose a method of producing a decorative *stained glass* effect window shade in the form of a light *transparent* elongated plastic film adapted to cover a window opening and having printed thereon a colored reproduction of an actual stained glass window assembly and produced by printing light transmitting **translucent** (See column 2, line 39) **colored inks** onto the transparent plastic film (See Abstract; claim 1) by **printing rollers, plates** (claimed lithography), screens (See column 2, lines 16-17; column 4, lines 3-4) using *any* suitable methods, e.g. rotogravure, flexograph, offset (both sheet fed and web), letterpress and silkscreening (rotary and flat bed) (See column 2, lines 18-20). The *plastic* film materials are any materials which provide **UV-light stability** (i.e. **includes UV protection**) (See column 1, lines 66-67), e.g. vinyl plastics such as **polyvinyl chloride** and vinylchloride, vinylidene chloride copolymers (See column 2, lines 1-3). The window shade can be attached at one end to a spring loaded roller 11 (See Fig. 1; column 1, lines 60-62).

Levy et al fails to teach that: (i) the window shade self-adheres to the window (Claims 40; the film has thickness of 4-10 mils (Claim 69); (ii) a top coat layer having opaciters is printed over the printed image (Claims 13, 41) such as matte varnish layer (Claim 62); the inks are printed using **lithographic** printing process (Claims 65, 70); sufficient **opaciters** are added **into** a top varnish layer (Claims 40-41).

As to (i), Idland teaches that window sun **curtains** or shades (See column 1, lines 60-64) made of a sheet of plasticized polyvinyl chloride (See column 2, lines 47-48) having thickness **less** than 0.02 inch (**20 mils**) (See column 1, lines 31-32) may be attached to the window surface electrostatically (See column 1, lines 27-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a film of Levy et al from a sheet of plasticized polyvinyl chloride having thickness less than 20 mils with the expectation of providing the desired cling film that may be attached to the window surface electrostatically, as taught by Idland.

As to (ii), Charley et al teach that a colored design 20 can be produced by **lithographic offset** printing process (See column 1, lines 21-35) to a clear or translucent cling vinyl film 16 (See column 2, lines 34, 45-55) of a film material 14, then covering with a very thin layer of *translucent* varnish 36 (claimed matte finish) (See column 2, lines 23-24, 55-58), thereby forming a *translucent* cling decal for covering a window (See column 4, lines 8-9). Charley et al further

teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27). Charley et al is silent that a translucent varnish can be made by adding sufficient opaciters to a clear varnish. Bakker et al teach that a composition can be made either transparent by using natural or synthetic transparent pigments, or *translucent* or opaque by using natural or synthetic opaque pigments: in *translucent* composition pigments are generally employed in amounts of up to about 6 weight % and in opaque composition pigments are generally employed in amounts of up to about 150 weight % (See column 5, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a translucent varnish of Charley et al by adding up to about 6 weight % of natural or synthetic opaque pigments into a clear varnish since Bakker et al teach that a clear composition can be made *translucent* by adding to the composition natural or synthetic opaque pigments in amounts of up to about 6 weight %.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed an image in Levy et al using clear or translucent inks by lithographic offset printing process, and covered it with a curable *translucent* varnish of Charley et al in view of Bakker et al with the expectation of providing the desired protected *translucent* image, as taught by Charley et al.

As to printing a top layer, it is well known in the art that a *printing* method is one of the conventional methods of applying coating layers.

As to multiple different colored layers, the image in Levy et al is created by applying multiple different colored layers, as described by Charley et al (See column 2, lines 49-55).

As to claims 74, 75, Idland teaches that a vinyl film shade of a size can be easily accommodated to a window size, as by employing multiple of the sheets on a window (and clearly by trimming) (See column 1, lines 6-10).

As to claims 78, 80, 85 and 86, Levy et al teach that the image is printed on the entire top surface of the transparent plastic film using translucent colored inks (See column 2, line 39), thereby printing a *translucent image* of the stained glass window contiguously across the entire top surface of the plastic film, i.e. providing opaciters by the printing the *translucent* image, as required by the claims.

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17. Claims 40-41, 60-65, 67-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over EtchArt, Inc. (Applicants' admitted prior art) in view of Levy et al, further in view of Charley et al, and further in view of Bakker et al.

EtchArt, Inc. teaches a method of producing a window covering which has printed etched glass image as alternative to a real etch glass. The sheet can be attached to the window without the use of adhesives or mechanical devices (See specification, page 4, last paragraph).

EtchArt, Inc. fails to teach that image of stained glass can be printed instead of etched glass image.

Levy et al teaches that a plastic sheet printed with a stained glass image may be used for covering window to imitate a real stained glass (See above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a stained glass image on a plastic sheet of EtchArt, Inc. with the expectation of providing the desired imitation of a real stained glass since Levy et al teaches that a plastic sheet printed with a stained glass image may be used for covering window to imitate a real stained glass.

All other limitations would be obvious over combination of Levy et al, Charley et al, and Bakker et al as was discussed above.

As to claim 69, It would be obvious to make the film having thickness of about 6 mils because Charley et al teach that a cling film having thickness of 6 mil can be used as a cling window covering (See column 2, lines 32-33).

18. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al in view of Idland, further in view of Charley et al/EtchArt, Inc. in view of Levy et al, further in view of Charley et al, and further in view of Bakker et al/, and further in view of Chmielnik.

Levy et al in view of Idland, further in view of Charley et al/EtchArt, Inc. (Applicants' admitted prior art) in view of Levy et al, further in view of Charley et al, and further in view of Bakker et al/ are applied here for the same reasons as above. Levy et al in view of Idland, further in view of Charley et al/EtchArt, Inc. (Applicants' admitted prior art) in view of Levy et al, further in view of Charley et al, and further in view of Bakker et al/ fail to teach that colors are provided by cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used primary colors of cyan, magenta and yellow in inks of Levy et al in view of Idland, further in view of Charley et al/EtchArt, Inc. in view of Levy et al, further in view of Charley et al, and further in view of Bakker et al/ with the expectation of providing the desired color images, since Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

19. Claims 78-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al in view of Idland, further in view of Charley et al/EtchArt, Inc. in view of Levy et al, further in view of Charley et al/, and further in view of Boden (US 3,562,941).

Levy et al in view of Idland/ EtchArt, Inc. in view of Levy et al are applied here for the same reasons as above. Charley et al teach that *either a clear or translucent* cling vinyl film 16 (See column 2, lines 33-34) can be used together with translucent top varnish layer 36 (See column 4, line 53) for making a translucent window covering. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent base vinyl film in Levy et al in view of Idland instead of clear base film of Levy et al with the expectation of providing the desired translucent window shade since Charley et al teach that either a clear or translucent cling vinyl film can be used together with translucent top varnish layer 36 for making a translucent window covering.

Levy et al in view of Idland in view of Charley et al/ EtchArt, Inc. in view of Levy et al in view of Charley et al fail to teach that the translucent vinyl sheet is made by applying a *translucent* matte finish to a top of a clear film material.

Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating (claimed matte finish) on its rear side can be used (See column 5, lines 73-75) for making daylight visual displays (See column 6, lines 43-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* matte coating on its rear side instead of the translucent vinyl sheet of Levy et al in view of Idland in view of Charley et al/ EtchArt, Inc. in view of Levy et al in view of Charley et al since Boden teaches that instead of translucent

plastic, a transparent plastic having a translucent coating on its rear side can be used for making daylight visual displays.

Obviously, the same daylight visual effect would be achieved in Levy et al in view of Idland in view of Charley et al/ EtchArt, Inc. in view of Levy et al in view of Charley et al, and further in view of Boden if clear film material 14 were having a *translucent* matte coating on its front side.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* coating on its front side instead of the translucent cling vinyl sheet of Levy et al in view of Idland in view of Charley et al/ EtchArt, Inc. in view of Levy et al in view of Charley et al, and further in view of Boden since obviously, the same daylight visual effect would be achieved if clear film material were having a *translucent* coating on its front side.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gill et al (US 6633666) teach that a **translucent** color "varnish" applied over a printed tints an overall image to add a *surface effect* on the printed image (See column 2, lines 6-11).

Response to Arguments

21. Applicants' arguments filed June 23, 2006 have been fully considered but they are not persuasive.

(A) Applicants argue that claims 40, 41, 59-65, and 67-88 comply with the written description requirement under 35 U.S.C. 112, first paragraph, because first, the present specification explicitly discloses an embodiment that achieves translucency without substantially raised portions such as frosted or embossed portions. See page 3, last sentence. A surface without substantially raised portions is substantially smooth and uniform. Second, in FIG. 3 the specification explicitly shows a window having film with a substantially smooth and uniform surface that radially disperses light. Third, the specification discloses a translucent window covering produced by printing varnishes and inks onto a polished surface without any embossing or frosting of the polished surface, which remains substantially smooth and uniform.

The argument is unconvincing because, in contrast to Applicants statement, the specification explicitly discloses that *no embossing* or lamination of a *frosted film* is used, which is not a proper support for claimed “substantially smooth and uniform” surface because claimed “substantially smooth and uniform surface” **does not exclude** surface irregularities on nanometer or micron levels **in the absence of definition of the term**. For the same reasons, FIG. 3 is not a proper support either because the scale of the Figure would not be able to show the surface irregularities on nanometer or micron levels.

(B) Applicants argue that claims 40, 78 and 87 comply with the written description requirement under 35 U.S.C. 112, first paragraph, because the specification discloses that opaciters may be applied as the final layer on the plastic substrate; however, the specification also states that “the invention has been successfully accomplished using different orders of applications.” See page 8, lines 8-11. Thus, the specification has support for printing opaciters before or after printing ink layers.

The Examiner disagrees. The phrase “the invention has been successfully accomplished using different orders of applications” are disclosed at page 8, lines 2-3 and 8-9, and relate to applications *before* application of the flood matte varnish topcoat containing opaciters. Note that opaciters are first mentioned at line 11 of the same page after the disclosure using different orders of applications”.

(C) Applicants argue that claim 63 complies with the written description requirement under 35 U.S.C. 112, first paragraph.

The argument is unconvincing because for the reasons stated in (B).

(D) Applicants argue that amendment of claims 40, 63, and 88 removes the rejection under 35 U.S.C. 112, second paragraph, and Claim 78 does not contain the rejected claim language.

The argument is unconvincing because printing sufficient opaciters does not clear whether opaciters printed themselves or with a varnish, and claim 78 does contain the rejected claim language of applying sufficient opaciters.

(E) Applicants argue that claims 40, 78 and 88 are definite under 35 U.S.C. 112, second paragraph. Applicants traverse any unsupported factual conclusions used to support the rejection. See Exhibit A.

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The Examiner assumed that Exhibit A is inventor's Declaration. However, the Declaration is not sufficient to overcome the rejection because **in the absence of definition of the term** in the specification as filed, claimed "substantially smooth and uniform" surface may include irregularities non physically noticeable surface irregularities or deformations.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER


August 4, 2006